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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,646	01/30/2001	Stephen J. Boies	YOR920000605US1	2755
35526	7590	03/24/2005	EXAMINER	
DUKE. W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			CABRERA, ZOILA E	
			ART UNIT	PAPER NUMBER
			2125	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,646

Applicant(s)

BOIES ET AL.

Examiner

Zoila E. Cabrera

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-190 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-190 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/30/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 177 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 177 includes the same limitations of claim 176.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 98 and 101 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims fall within the category of a "process" under 101, the steps are so broadly recited, without regard to any tangible way of implementing them, that they are directed to the "abstract idea" itself and the claims are nonstatutory subject matter under the "abstract idea" exception. The abstract ideas comprising the steps are not instantiated into some specific physical implementation. Nor are there any minor physical acts, such as recording, that might be construed as an implementation of the abstract idea.

To expedite a complete examination of the instant application claims 98 and 101 rejected under 35 U.S.C. 101 (non-statutory) above is further rejected as set forth below

in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 13-27, 31-42, 46-57, 61-71, 75-85, 89-94, 98-105, 110-117, 126-128 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lof et al. (US 6,671,585 B2)**.

Regarding claims 1, 19 and 37, **Lof** discloses a method, system and computer program product for managing a utility service, comprising the steps of:

- analyzing relationship information representing a relationship of availability of the utility service and consumption of the utility service (Col. 13, lines 37-46; Col. 16, lines 35-42); and, sending a message over a data network to at least one region of a utility service network to thereby modify utility service consumption based on the analysis of the relationship information (Col. 16, lines 40-58 and lines 64-67, please note that load shedding takes place at times of lowered production capacity wherein a message has to be sent in order to cut back the power to

Art Unit: 2125

certain customers who have agreed to have their power cut back. See also Col. 11, lines 62-65; Col. 12, lines 25-31 and 43-45, i.e., the utility consumption of the hydroelectric would be modified according to the needs of the wind farm).

Regarding claims 2-9, 13-18, 20-27, 31-36, 38-42, 46-51, 53-57, 61-65, 67-71, 75-79, 81-85, 89-93, 100, 110-111, 126-127, **Lof** discloses,

- the message instructs at least one region permitting increased power consumption (Col. 1, lines 65- Col. 12, line 2);
- the message instructs at least one region permitting decreased power consumption (Col. 12, lines 25-31; Col. 13, lines 41-46);
- the message modifies permitted power consumption for aggregated regions (Col. 16, lines 40-42, i.e., aggregated regions reads on any customer who has a contract in any region wherein the power is modified as agreed in the contract).
- the data network is the Internet (Col. 13, lines 5-9);
- the data network includes at least one of a wireless link (Col. 13, lines 12-14) and a Bluetooth connection;
- the data network contains at least one link sharing physical wiring with the utility service network (Col. 13, lines 5-12).
- sending the message to at least one region includes broadcasting the message to multiple regions (Fig. 22, steps 2201-2205, please note that message is sent to one or a group of candidate existing providers);

Art Unit: 2125

- transmitting the message as a multicast message to multiple regions (Fig. 22, steps 2201-2205, please note that message is sent to one or a group of candidate existing providers);
- the utility service is providing electricity (Col. 12, lines 25-31);
- at least one region **is one of** a single power consuming device, a subset of a plurality of power consuming devices, a portion of the utility service network in a geographic region, and a consumption management service provider (Col. 12, lines 59-67);
- the message instructs at least one region to modify at least one term or condition of sale (Fig. 27A, step 2701; Fig. 28B step 2817);
- the term or condition of sale is at least one of price and a pricing method (Fig. 28B step 2817);
- modifying at least one term or condition of sale includes varying the price of the utility service based on a rate of consumption of the utility service (Col. 32, lines 9-21);
- analyzing historical data relating conditions of sale of the utility service to consumption levels of the utility service; and generating the message based on the analysis of the relationship information and the analysis of the historical data.

Regarding claims 52, 66, 80, 94, 98 and 99, **Lof** teaches, a method, apparatus and readable medium for managing consumption of a utility, comprising:

- receiving a message from a utility service provider (Col. 33, lines 43-48, i.e., control message is sent to the alternative energy production facility); generating

Art Unit: 2125

at least one message for at least one region of a utility service network, the at least one message instructing a region to modify utility consumption by the at least one region; and sending the at least one message to the at least one region (Col. 33, lines 58-65; Col. 12, lines 25-31).

With respect to claims 101, 112, 113, 128, **Lof** discloses, a method and apparatus for providing utility service to a customer system, comprising:

- analyzing an operation of a utility system (Col. 12, lines 25-28); and, sending a message to the customer system changing a service parameter based on the analysis of the operation of the utility system (Col. 12, lines 28-31; Col. 11, lines 61-65).

As for claims 102-105, 114-117,

- the message sent to the customer system instructs the customer system to change the service parameter such that the customer system ceases operations (Col. 13, lines 30-35);
- the message sent to the customer system instructs the customer system to change the service parameter such that the customer system resumes operations (Col. 13, lines 30-35);
- the message sent to the customer system instructs the customer system to change the service parameter such that the customer system consumes decreased power supply (Col. 13, lines 41-48);

Art Unit: 2125

- the message sent to the customer system instructs the customer system to change the service parameter such that the customer system consumes increased power supply (Col. 13, lines 41-48).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12, 28-30, 43-45, 58-60, 72-74, 86-88, 95-97, 106-109, 118-125 and 129-190 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lof et al. (US 6,671,585 B2)** in view of **Johnson et al. (US 2004/0015433 A1)**.

Regarding claims 10-12, 28-30, 43-45, 58-60, 72-74, 86-88, 95-97, 106-109, 118-125 and 129-190, the same citations applied to claims 1-9, 13-27, 31-42, 46-57, 61-71, 75-85, 89-94, 98-105, 110-117, 126-128 above apply as well for these claims. However, **Lof** fails to disclose associating a customer system with *a class of utility service*; identifying a class of utility service, and *changing the class of utility service*. **Lof** further fails to disclose auctioning or negotiating a class of utility service and changing dynamically or unilaterally the class of utility service; the change of class of utility service is based on a cost increase, decrease or available amount of utility service. But **Johnson et al.** discloses associating a customer system with *a class of utility service* and identifying a class of utility service, and *changing the class of utility service* (Page 4,

Art Unit: 2125

[0021]; Page 2, [0009], lines 4-11). **Lof** further fails to disclose auctioning or negotiating a class of utility service (Page 3, [0017], lines 10-20; Page 4, [0019]); and changing dynamically or unilaterally the class of utility service (Page 2, [0012]); the change of class of utility service is based on a cost increase, decrease or available amount of utility service (Page 5, [0042], lines 21-46; [0025]).

Therefore, it would have been obvious to a person of the ordinary skill in the art at the time the invention was made to combine the power production facility of **Lof** with the bidding for energy supply to customers system of **Johnson** because it would provide an auction service that will stimulate competition and facilitate the consumer's ability to make economic choices between providers (**Johnson**, Page 3, [0017], lines 10-20)

Conclusion

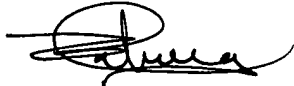
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning communication or earlier communication from the examiner should be directed to Zoila Cabrera, whose telephone number is (571) 272-3738. The examiner can normally be reached on M-F from 8:00 a.m. to 5:30 p.m. EST (every other Friday).

If attempts to reach the examiner by phone fail, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. Additionally, the fax phones for Art Unit

Art Unit: 2125

2125 are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at (703) 305-9600.

A handwritten signature in black ink, appearing to read 'Zoila Cabrera', with a stylized flourish at the end.

Zoila Cabrera
Patent Examiner
3/21/05